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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,507	01/30/2004	Gerhard Maier	GP-303288	6878

7590 11/15/2006

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EXAMINER

FIGUEROA, JOHN J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/768,507

Applicant(s)

MAIER ET AL.

Examiner

John J. Figueroa

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1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 13-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/30/04 & 3/1/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 13-24 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on August 28, 2006.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 2001/19896 A1 to Wilson et al., hereinafter 'Wilson'.

Wilson discloses a composite ion-exchange membrane formed comprising a conductive block polymer (ion-conducting polymer) and supporting material for the block polymer of at least two different units; said polymer having hydrophobic and hydrophilic segments and preferably a sulphonated segment; wherein said polymer segments encompass the general formulas recited claims 5-7, wherein Y=CO, Z and G can be OH

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or a halogen, Q is a sulfonated group ($-\text{SO}_3\text{M}$) and m can be a positive integer up to about 12. (Page 2, lines 9-20; page 3, lines 1-12, Formula III; page 5, lines 11-24 and 30-35; page 6, lines 1-15 and 28-33; page 8, lines 10-21, Formula IV; page 9, lines 13-18, Formula V)

Wilson further discloses that the substituent corresponding to "Y" in the instant claims (i.e. "G") can be CO, SO₂, oxygen or a phenol moiety (an aromatic ring) thus disclosing segments having different "Y" moieties. (Page 3, lines 7-8, Formula V*; page 30, lines 1-11, formula VII) Wilson also discloses that the substituents can be selected from among alkyls, nitro, nitrile, hydroxyl, halogens and trifluoromethyl phenol substituents. (Page 6, lines 20-25) Wilson discloses that the porous support material for the conductive polymer may be a fabric or microporous membrane. (Page 33, lines 1-8)

Although Wilson does not expressly disclose the molar mass of a segment of the disclosed block polymer to be between 500 and 500,000 g/mol (a very large range) because Wilson and the instant claims encompass the ion-conductive membrane, then both membranes must inherently possess similar physical properties, such as molar mass.

Thus, the instant claims are anticipated by Wilson.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson.

Wilson was disclosed above. Wilson does not expressly disclose the molar mass of a segment of the block copolymer or the microporous membrane in the form of a sphere, cylinder, lamella or diamond.

However, it would have been obvious to a person of ordinary skill in the art at the time that the claimed invention was made to produce Wilson's microporous membrane in any desired shape and/or having a preferred mass. It would have been obvious for one skilled in the art to do so to attain a microporous ion conducting membrane optimized for a particular application.

Moreover, Applicant has not provided any evidence as to the criticality of the membrane shape or molar mass to the practice of the claimed invention. See In re Dailey, 149 USPQ 47 (CCPA 1966) (the court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant).

Thus, the instant claims are unpatentable over Wilson.

Conclusion

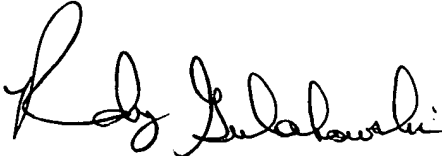
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571) 272-8916. The examiner can normally be reached on Mon-Thurs & alt. Fri 8:00-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJF/RAG


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